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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,635	11/02/2001	Joseph C. Salamone	P02866	8360

7590

03/14/2003

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EXAMINER

PENG, KUO LIANG

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 03/14/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/003,635

Applicant(s)

SALAMONE ET AL.

Examiner

Kuo-Liang Peng

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 2/7/03 Response.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-13 and 19-28 is/are rejected.
- 7) ☒ Claim(s) 7-13 and 19-28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1712

### DETAILED ACTION

1. Applicant's election of the invention of Group III in Paper No. 6 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The requirement is still deemed proper and is therefore made FINAL.

Groups I-II and IV-V, Claims 1-6 and 14-18, are withdrawn for further consideration.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 7-13 and 19-28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-13 and 19-28 of copending Application No. 10/000,136. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons: When z is 0 in the siloxysilane monomers set forth in the copending Application, Claims 7-13 and 19-28 of the

Art Unit: 1712

copending Application obviously disclose Claims 7-13 and 19-28, respectively, of the present Application wherein y is 1 in the siloxysilane monomers.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. The following are Examiner's suggestions/questions:

In Claim 27, before "methacrylate", should there be -- cycloalkyl --?

#### *Claim Objections*

5. Claims 7-13 and 19-28 are objected to because of the following informalities:

It is noted that the limitation of Claim 1 should be included in Claims 7-10 and 19-26. It is further noted that in Claim 1 (page, line 2), should "alkyl", "alkyloxy", "aryl" and "aryloxy" be -- alkylene--, -- alkyleneoxy --, -- arylene -- and -- aryleneoxy --, respectively?

Appropriate correction is required.

#### *Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 7-13 and 19-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Toyashima (US 4,954,586).

.Art Unit: 1712

With respect to Claim 7, Toyashima discloses a polymeric composition comprising tris(trimethylsiloxy)silylpropyl (meth)acrylate (i.e., reads on "one or more monomers" wherein y is 0, and R<sup>1</sup> is methyl, X is propylene and R is (meth)acryloxy) (col. 11, line 65-66) and components (A) to (D) (col. 3, line 14 to col. 4, line 35).

With respect to Claims 8 and 11, Toyashima further teaches the use of methyl methacrylate (col. 7, lines 12-13) or N,N-dimethyl acrylamide (col. 11, line 47).

With respect to Claims 9 and 12, Toyashima further teaches the use of 2-ethylhexyl methacrylate (col. 7, line 18).

With respect to Claims 10 and 13, Toyashima further teaches the use of N,N-dimethyl acrylate (col. 11, line 47) or N-methyl acrylamide (col. 11, line 45).

With respect to Claims 19-22 and 27, Toyashima further teaches the use of cycloalkyl (meth)acrylate such as cyclopentyl (meth)acrylate or cyclohexyl (meth)acrylate (col. 7, lines 12 and 21-22).

With respect to Claims 23-26 and 28, Toyashima further teaches the use of a crosslinking agent such as ethylene glycol di(meth)acrylate, triethylene glycol di(meth)acrylate, etc. (col. 10, line 44 to col. 11, line 6).

8. Claims 7-12, 23-26 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Gaylord (US 3,808,178).

With respect to Claim 7, Gaylord discloses a polymeric composition produced through the polymerization of a polysiloxanylalkyl ester monomer described in col. 1, line 61 to col. 2, line 9, wherein X and Y is a group of Z, and A is C<sub>1</sub>-C<sub>5</sub> alkyl group and phenyl groups. It is

.Art Unit: 1712

noted that the phenyl substituents on the polysiloxanyl monomer enhance the refractive index of the polymeric composition (col. 5, lines 28-30).

With respect to Claims 8-9 and 11-12, Gaylord further teaches the use of an alkanol ester of (meth)acrylic acid such as methyl methacrylate, 2-ethylhexyl (meth)acrylate, etc. (col. 1, lines 29-44 and col. 3, lines 59-60).

With respect to Claim 10, Gaylord further teaches the use of a hydrophilic monomer (col. 4, lines 50-62).

With respect to Claims 23-26 and 28, Gaylord further teaches the use of a crosslinking agent such as ethylene glycol dimethacrylate, butylene glycol dimethacrylate, neopentyl glycol diacrylate, etc. (col. 5, lines 6-14).

9. The references cited in the specification US 4,327,203, US 4,355,147, US 5,270,418, US 5,217,491 and US 5,326,506 have been considered.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (703) 306-5550.

The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Application/Control Number: 10/003,635

Page 6

Art Unit: 1712

Kuo-Liang Peng

March 3, 2003

A handwritten signature in black ink, appearing to read 'Kuo-Liang Peng', written in a cursive style.